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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/763,704 02/26/01 WITSCHER

M 49365  
EXAMINER

HM12/1024

AFT UNIT PAPER NUMBER  
ROBINSON, B 7

KEIL & WEINKAUF  
1101 CONNECTICUT AVENUE N W  
WASHINGTON DC 20036

1625  
DATE MAILED:

10/24/01

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire ONE month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.        | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.             | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____   |

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1-25 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☐ Claims \_\_\_\_\_ are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☒ Claims 1-25 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.95 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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EX

Art Unit: 1625

**DETAILED ACTION*****Election/Restrictions***

The examiner notes the applicant's election of species 1 at paper no. 6/B. The election of species will be used as a reference point for the examiner to create a natural genus based on a liberal interpretation of the doctrine of legal and chemical equivalence and restriction will be required under 35 U.S.C. 121 and 372.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) to 1-25, drawn to the compound of formula I where R1 are all of the radicals claimed except heterocycloxy and heterocyclylthio, R2 and R3 are hydrogen, C1-C6-alkyl, C1-C6-haloalkyl or halogen, R4 is formula IIa where R6 is Nitro, halogen, cyano, C1-C6-alkyl, C1-C6-haloalkyl, di(C1-C6-alkoxy)methyl, di-(C1-C6-alkylthio)methyl, (C1-C6-alkoxy)(C1-C6-alkylthio)methyl, hydroxyl, C1-C6-alkoxy, C1-V6-haloalkoxy, C1-C6-alkoxycarbonyloxy, C1-C6-alkylthio, C1-C6-haloalkylthio, C1-C6-alkylsulfinyl, C1-C6-haloalkylsulfinyl, C1-C6-alkylsulfonyl, C1-C6-haloalkylsulfonyl, C1-C6-alkylcarbonyl, C1-C6-haloalkoxycarbonyl, I is 0 to 6, R5 is halogen, OR7, SR7, SOR8, SO2R8, OSO2R8, R8 and R9 are C1-C6 alkyl, C3-C6-alkenyl, C3-C6-haloalkenyl, C3-C6-alkynyl, C3-C6-haloalkynyl, C3-C6-carbocyclicalkyl, hydroxyl where R7 is C1-C6 alkyl, C3-6alkenyl, C3-6 haloalkenyl, C3-6 haloalkynyl, C3-6 cycloalkyl, a

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Art Unit: 1625

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while providing enablement for R1\*\*\* of formula \*\*\* in claim \*\*\* coming together to form \*\*\* on page \*\*\* of the specification, does not reasonably provide enablement for the radicals R\*\*\* and R\*\*\* of formula \*\*\* coming together to form all of the possible tricyclic type of polycyclic N-heterocyclic systems. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The claims as recited are broader than the scope of enablement. The specification lacks direction or guidance for placing all of the alleged products in the possession of the public without inviting more than routine experimentation. The applicant is referred to *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) which includes the incorporation of the 8 factors recited in Ex parte Foreman 230 USPQ 546 (Bd. Of App. And Inter 1986).

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